



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/518,124	12/15/2004	Ingo Luer	PAT-01077	3274

26922	7590	01/14/2008
BASF CORPORATION Patent Department 1609 BIDDLE AVENUE MAIN BUILDING WYANDOTTE, MI 48192		

EXAMINER	
FIGUEROA, JOHN J	

ART UNIT	PAPER NUMBER
1796	

NOTIFICATION DATE	DELIVERY MODE
01/14/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

LORI.HASS@BASF.COM
MARJORIE.ELLIS@BASF.COM
ANNE.SABOURIN@BASF.COM

Office Action Summary	Application No. 10/518,124	Applicant(s) LUER ET AL.	
	Examiner John J. Figueroa	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4, 5, 7-10 and 12-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 5, 7-10, 12-17 and 19 is/are rejected.
- 7) ☒ Claim(s) 18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The 35 U.S.C. 102(b) rejection of claims 1, 4, 5, 7-10 and 12 as anticipated by United States Patent Number (USPN) 6,168,865 B1 to Koster et al. (hereinafter 'Koster') previously made of record in item 1 on page 2 of the Office Action of July 20, 2007 (hereinafter 'OA') has been withdrawn in view of Applicant's amendment to the claims in the response to OA filed October 19, 2007 (hereinafter 'Response').

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1, 4, 5, 7-10, 12-17 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 6,166,150 to Wilke et al. (hereinafter 'Wilke').

Wilke discloses a composition comprising a paint binder based on a polyacrylate-modified polyurethane-alkyd resin composition comprising 90 to 30 parts by weight of an unsaturated C6 to C30 fatty acid- (having at least two nonconjugated double bonds), and from 10 to 70 parts by weight of an unsaturated C6 to C30 fatty acid- (having at least two conjugated double bonds) esterified polymer side chains of a polyurethane/alkyd resin component; wherein

the polyurethane resin component has from 95 to 50% by weight of polyurethane units with monomer building blocks having anionic groups, or groups which can be converted by neutralization into anionic groups, as polymer main chains of the polyurethane/alkyd resin component; and wherein the polyurethane/alkyd resin component is converted, with or without neutralization, into an aqueous dispersion or solution, to prepare a binder dispersion comprising an acrylate-modified polyurethane-alkyd resin (contains hydroxyl group). (Abstract; col. 2, lines 20-48) The polymerization is conducted in a solution or dispersion comprising the polyurethane/alkyd resin with at least one ethylenically unsaturated monomer having essentially no reactive functional group other than the double bond, or with a mixture of such monomers, in the presence of a free-radical polymerization initiator (Col. 2, lines 48-57) (Examiner notes that the specification on page 27, line 19 to page 28, line 9 states that the fatty acid modified epoxy ester/alkyd component can be introduced into the basecoat material at any desired point during the preparation of the basecoat material).

Wilke discloses that preferred ethylenically unsaturated monomers are (meth)acrylic esters, vinylaromatic compounds and vinyl esters (col. 3, lines 1-3) and that the molecular weight of the polyurethane resin is generally between 1,000 and 100,000 (col. 5, lines 57-63). The composition can be used to formulate a paint composition that can further contain an organic/inorganic pigment (col. 7, lines 24-42), wherein this paint formulation can be applied alone or together with another coated composition as a clearcoat, basecoat or topcoat

(col. 8, lines 15-30), and wherein the substrate for the paint can be iron, steel, glass or wood (common substrates in automobiles). (Col. 8, lines 31-48)

Although Wilke does not expressly disclose an "automotive paint system" (claims 9 and 10), this limitation is an intended future use of the claimed invention. A future use limitation must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, it therefore meets the claim.

Thus, the claims are anticipated by Wilke.

Allowable Subject Matter

4. Claim 18 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art of record (particularly, Wilke) does not teach or suggest a binder of the coating composition in accordance with instant claim 1 that comprises *graft* copolymers of an ethylenically unsaturated monomer and a polyurethane resin.

Response to Arguments

The 35 U.S.C. 102 Rejection over Koster (item of OA)

5. Applicant's arguments with respect to the captioned 102 anticipation rejection over Koster have been considered but deemed moot due to the

withdrawal of this rejection in view of Applicant's amendment to the claims in Response amending the binder of the composition of independent claims 1, 4 and 12 to be obtained by polymerizing an ethylenically unsaturated monomer in the presence of a polyurethane resin.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Figueroa whose telephone number is

Application/Control Number:
10/518,124
Art Unit: 1796

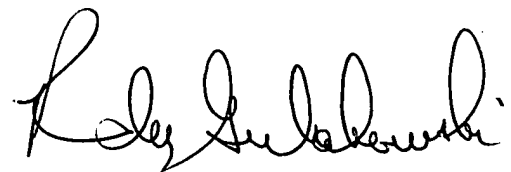
Page 6

(571) 272-8916. The examiner can normally be reached on Monday-Thursday
8:00-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the
examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302.
The fax phone number for the organization where this application or proceeding
is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from
the Patent Application Information Retrieval (PAIR) system. Status information
for published applications may be obtained from either Private PAIR or Public
PAIR. Status information for unpublished applications is available through
Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR
system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-
free). If you would like assistance from a USPTO Customer Service
Representative or access to the automated information system, call 800-786-
9199 (IN USA OR CANADA) or 571-272-1000.

JJF/RAG



RANDY GULAKOWSKI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700